UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/693,317	10/20/2000	Kia Silverbrook	ART85US	8404

24011   7590   05/04/2005

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EXAMINER
POON, KING Y

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 January 2005</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
     closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-5</u> is/are pending in the application.

     4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-5</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>18 August 2004</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

     a)☐ All   b)☐ Some * c)☐ None of:

       1.☐ Certified copies of the priority documents have been received.

       2.☐ Certified copies of the priority documents have been received in Application No. _____.

       3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
          application from the International Bureau (PCT Rule 17.2(a)).

     * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
     Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
     Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1, 3, 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Matsunoshita (6,603,864) in view of Soscia (US 5,996,893).

In accordance with claim 1, Matsunoshita discloses an apparatus 52 (figure 20)

of reading digital data (e.g., bar codes, column 17, lines 50-60, additional data, column

18, lines 1-20) including encoded image data (bar code, inherently, is encoded image

data) printed on a printed media in invisible ink (column 17, lines 53).

Matsunoshita further discloses that the apparatus includes a scanner means 57

for scanning in the invisible ink data (encoded image data) on the printed media (col. 18

lines 8-9, note; a scanner system such as the system of Matsunoshita is a camera

system, that used to create the bar code, column 17, lines 19-27).

Matsunoshita further discloses that the apparatus includes means for advancing

the print media through the scanner means and means for illuminating the print media

with invisible radiation (col. 17 lines 51-65).

Matsunoshita further discloses that the apparatus includes means 55 for

processing the data output from said scanner means including means for decoding said

data; in Matsunoshita's system, the scanner means 57 detects infrared data on the image and the embedding unit 55 processes the data output from the scanner means 57 for decoding and sends it to the personal computer (col. 18 lines 14-18).

Matsunoshita further discloses that the apparatus includes ink jet printer means for printing out the image derived from said decoded data on a print media attached to said ink jet means, in Matsunoshita's system, print 51 uses 5 inks to print the images YMCK and IR toner (col. 16 lines 62-65).

Matsunoshita does not teach the print media is a photograph with printed invisible digital data. However, scanning a photograph is inherent properties of a scanner.

Soscia, in the same area of printing and scanning invisible image on a printed media (column 1, lines 40-45, column 5, lines 30-40, column 6, lines 60-65), teaches scanning a photograph (column 1, lines 40-45) printed with digital images (column 5, lines 30-40, column 6, lines 60-65).

Therefore, it would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the print media of Matsunoshita to include a photographs with digital data printed in invisible ink.

It would have been obvious to a person with ordinary skill in the art at the time the invention was made to have modified the print media of Matsunoshita by the teaching of Soscia because of the following reasons: (a) since digital camera becomes more popular, it is desirable of creating photographs having digital data printed with invisible ink, column 1, Soscia; and (b) it would have allowed Matsunoshita's system to

be widely used by users of digital camera without any modification to the system of

Matsunoshita.

In accordance with claim 4, Matsunoshita discloses that the printer 51 embeds

the data printed in IR ink into the image printed from the image data (col. 16 lines 4-6

and 8-9).

In accordance with claim 3, Matsunoshita discloses using IR ink as the invisible

ink (col. 16 line 6).

3.   Claims 2, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Matsunoshita (6,603,864) in view of Soscia (US 5,996,893) as applied to claim 1 above,

and further in view of Zhang (US 5,771,245).

In accordance with claims 2 and 5, Matsunoshita does not disclose expressly

that the image data is encoded and decoded using the Reed-Solomon process.

Zhang discloses using the Reed-Solomon process to encode/decode data (col. 4

lines 18-20).

Matsunoshita and Zhang are combinable because they are from the same field of

endeavor, namely two-dimensional data encoding and decoding.

Therefore, at the time of invention, it would have been obvious to a person of

ordinary skill in the art, to use the Reed-Solomon process, as taught by Zhang, as the

encoding/decoding process in Matsunoshita's system.

The motivation for doing so would have been that the Reed-Solomon process is

a well-known process in the art to protect encoded data (Zhang: col. 4 lines 18-20).

Response to Arguments

4.   Applicant's arguments filed on 1/24/20005 have been fully considered but they

are not persuasive.

With respect to applicant's argument that the examiner has stated that

Matsunoshita specifically teaches encoding and decoding bar codes and copy right

information and has conceded that Matsunoshita does not teach the encoding of image

data such that the image can be reproduced from the encoded data.

In reply: The applicant is right that the examiner has stated that Matsunoshita

specifically teaches encoding and decoding bar codes.

Examiner has not conceded that Matsunoshita does not teach the encoding of

image data such that the image can be reproduced from the encoded data; the

Examiner states that Matsunoshita does not disclose expressly the encoding of image

data bottom of page 3, top of page 4, office action mailed 12/1/2004.

Claim 1 is claiming "digital data" being printed on a photograph, the photograph

including "an image." In other words, the photograph has "printed digital data" and "an

image." The examiner states that Matsunoshita specifically teaches encoding and

decoding bar codes which is the "printed digital data" and does not teach encoding the

"an image." The amended claim clarifies that the encoding is for the "printed digital

data" and not the "an image." The examiner maintained that Matsunoshita specifically

teaches encoding the "printed digital data" as previously stated.

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Conclusion

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to King Y. Poon whose telephone number is (571) 272-

7440

April 30, 2005

KING Y. POON
PRIMARY EXAMINER